

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of :
DANIEL A. GATELY : Art Unit 1621
Serial No. 09/016,641 :
Filed: January 30, 1998 : Examiner: J.Vollano
FOR: SILYLATED AND N-SILYLATED :
COMPOUND SYNTHESIS :

**RENEWED PETITION REQUESTING RECONSIDERATION
OF "PETITION DECISION" MAILED SEPTEMBER 21, 1999**

Honorable Commissioner of
Patents and Trademarks
Washington, D.C. 20231

Sir:

The September 21, 1999 "Petition Decision" states:

Any request for reconsideration or review of this decision must be by way of a renewed petition and must be filed within TWO MONTHS of the mailing date of this decision in order to be considered timely. [p. 3]

This "Renewed Petition" is procedurally proper and timely filed on Monday, November 22, 1999.

Grounds in Support of This Renewed Petition

The September 21, 1999 Petition Decision ("Decision") should be reversed and the relief sought by the Petition under 37 C.F.R. §1.144 ("Petition") filed May 28, 1999 should be granted for the following reasons:

1. The September 21, 1999 Decision deliberately and repeatedly mischaracterizes the Petition. The statements in the Decision that:

(i) "Applicants [sic] appear to rely on the provisions of M.P.E.P. 803.02..." [p. 1]; and

(ii) "Applicant appears to base his arguments primarily on the above section of the M.P.E.P." [pp. 2-3]

are simply not true. There is no reference anywhere to M.P.E.P. 803.02 in any of applicant's arguments. The Decision's use of the word "appears" is a contrivance necessary to find some pretext for denying the Petition. The Decision should be reversed for lack of candor.

2. Contrary to the Decision, "Reason 1" in the Petition contains no reference to M.P.E.P. 803.02. Instead, that Reason 1 clearly states what applicant does rely on:

As noted in the Request for Reconsideration: "Pursuant to 35 U.S.C. §103(a), claimed inventions¹ are to be considered and acted upon by the examiner 'as a whole'" (emphasis added). (A claimed invention is unpatentable "if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious..."; 35 U.S.C. §103(a).) Under 35 U.S.C. §121 (1994): "If two or more independent and distinct inventions are claimed in one application, the Commissioner may require the application to be restricted to one of the inventions".

¹ The Decision states: "By applicant's own admission (i.e.- "inventions"), there is more than one invention set forth in claim 1 and other claims" (p. 3). This is another mischaracterization of the Petition, which takes the word "inventions" out of context, that is made in another effort to find some pretext for denial of it. Applicant has not made any "admission" of any fact or circumstance which compromises any aspect of the relief sought by the Petition.

The word "invention" must have the same meaning in §103(a) and §121 of Title 35. Therefore, the word "invention" in §121 must mean the claimed "subject matter as a whole", just as in §103(a). For that reason, it is indeed "inappropriate...to restrict within a claim" (action, p. 9).

Further, the Examiner's notion that there may be "multiple inventions in a claim" which therefore "can be restricted into the different inventions" (id) clashes not only with §103(a) but also with §112. If such a restriction were permitted, it would force the applicant to fragment the claimed "subject matter as a whole" into a plurality of claims, none of which actually "point[s] out and distinctly claim[s] the subject matter [as a whole] that the applicant regards as his invention or discovery". 35 U.S.C. §112; 37 C.F.R. §1.75(a). [pp. 2-3]

Actually, the Decision's only response to this focal argument set forth in the Petition is:

It is noted that applicant argues that the examiner must examine the "inventions" as a whole.... The examiner has identified which claims are related to each separate invention claimed. Obviously claim 1 relates to two inventions, as determined by the examiner, thus implying that only part of claim 1 relates to the first claimed invention and part relates to the second claimed invention. Applicant's characterization of the restriction requirement based on including parts of a claim in separate groups as illogical is not found persuasive based on the above action by the examiner.... [p. 3; emphasis added.]

This statement in the Decision is just an evasion of applicant's actual position as stated in the Petition and quoted above. Applicant requests a clear answer to this position—which the Decision ignores—including an explanation of why it is not only persuasive but also mandated by the cited statutes and rules.

The Decision states:

The criteria for requiring an election of species in a Markush group, as noted above, is that the compounds share a substantial structural feature disclosed as essential to the utility claimed. The examiner could find no shared substantial structural feature directed to the utility claimed and therefor a restriction requirement was made. The examiner also gave extensive reasons for restriction including basic versus acidic properties, reactivities, etc. For the same reasons, the claims directed to the making of the individual compounds, claims 7 and 8, were divided into two separate groups corresponding to the restriction of the compounds in Groups I and II. The claims of Group V are to making compounds not related to the compounds of Groups I-IV and are thus properly restrictable. [p. 3; emphasis in original]

Under those "criteria", the proper procedure was for the examiner to require "election" as between the two "species" said to be recited in claim 1. The examiner is without power to, in effect, order such a claim 1 species election sua sponte, and then combine the sua sponte elected species with sua sponte elected fragments of another claim and demand "restriction" as to the artificial "invention" so created by the examiner but never claimed by applicant.

DEPOSIT ACCOUNT AUTHORIZATION

Please charge any fees due in connection with this Renewed
Petition to Deposit Account No. 09-0948. A duplicate is
attached.



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